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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,403	04/18/2001	Thomas J. Kennedy III	P-5907 SLD 2 0236	7628

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EXAMINER

BUTTNER, DAVID J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 06/20/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/837,403

Applicant(s)

KENNEDY ET AL.

Examiner

David Buttner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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No references were provided in conjunction with the IDS.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-17, 19 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phthalic acid and terephthalic acid of claim 1 and 19 do not qualify as isophthalic acid. "Isophthalic acid polyamide" must be construed as requiring units from isophthalic acid. Any other interpretation would be repugnant to the ordinary meaning.

"Olefin ester" of claims 12 and 13 is not the copolymer of olefin and acrylate intended. The specification does not suggest any compounds having both an olefin (i.e. unsaturated) group and an ester group.

It is not possible that the polyamide including units from isophthalic acid could be a "homopolymer" as required in claim 16. A diamine monomer must have been included because a polyamide cannot be made solely from an acid.

It is not seen how claim 30 limits claim 29.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 29 and 30 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Bissonette Patent.

Bissonette teaches golf balls having a center, a cover and a wound thread layer in between. The thread can be polyphenylene terephthalamide (col. 6, line 25).

Claims 1-7, 11, 15, 16, 18-24 and 29-31 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Rajagopalan '862 Patent

Rajagopalan suggests two or three piece golf balls. At least one of the layers is a sulfonated or phosphonated ionomer optionally blended with a polyamide (col. 29, line 51-53). The polyamide can be based on isophthalic acid (col. 30 line 55).

Claims 18 - 21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(b) as obvious over the Deleens Patent.

Deleens produces golf ball covers of polyether-ester-amide. Terephthalic or isophthalic acid (col. 3, line 42) can be used in the synthesis.

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Claims 1-7, 11, 14-24 and 31 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over J10305116 Patent.

The reference blends ionomer and polyetheramide for use as golf ball covers. The polyetheramide also contains aromatic ester groups (see formula I).

Presumably the same interactions between the ionomer and polyamide will be present in the reference as is for applicant (page 8 lines 5-17).

Claims 1-7, 11, 14-24 and 31 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the J62022841 Patent.

The reference produces golf ball covers of ionomer and a polyester amide from terephthalic acid (see registry No. 110485-64-8).

Claims 1-11 and 14-31 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Rajagopalan WO 98/40127 Patent.

Rajagopalan claims golf ball covers of 10-80% ionomer and 90-20% polyamide (claim 1). The polyamide can include units from terephthalic acid (page 15 line 4). The COR is high (Table II). Some of the ionomers used by Rajagopalan (i.e. surlyn 9320, 9020, 8320) are known to be terpolymer ionomers which are based on ethylene/acrylate/acid terpolymers (see applicant's Table 6). These ionomers have ester groups.

Claims 8-10 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Rajagopalan '862 Patent or the Deleens Patent or J10305116 or J62022841 or Rajagopalan WO 98/40127 in view of Sullivan '304.

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The primary references may not report compression or COR values for their balls. However, these values are conventional as shown by Sullivan's table (col. 23). It would have been obvious to ensure the balls of primary references have compression and COR values within normal parameters.

Claims 1-31 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Melanson '140 Patent.

The reference clearly meets the claims.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefore ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 17 rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6384140. This is a double patenting rejection.

Claims 1-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6384140. Although the conflicting claims are not identical, they are not patentably distinct from each other because the current application also claims blends of ionomer with polyphthalamide except that the claims are broader in the sense that ethylene/acrylate is not required to be present and the ionomer is open to being any ionomeric material.

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Bersted (col. 4 line 42-49) is cited for its definition of polyphthalamide that allows for units other than terephthalamide and isophthalamide.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is (703) 308-2403. The examiner can normally be reached on weekdays from 10 a.m. to 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on (703) 308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 305-7115 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

DAVID J. BUTTNER
PRIMARY EXAMINER

D. Buttner/dh
June 14, 2002

